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In re Application of
HAGHIRI, Yahya et al.
Application No.: 09/926,010
PCT No.: PCT/EP00/01272
Int. Filing Date: 16 February 2000
Priority Date: 17 February 1999
Attorney's Docket No.: HAGH3001/JEK
For: PORTABLE DATA SUPPORT WITH A
DETACHABLE MINI CHIP CARD

DECISION ON
REQUEST
UNDER 37 CFR 1.42

This is a decision on applicants' "Renewed Submission Under 37 C.F.R. §1.42" filed on 15 April 2003.

BACKGROUND

On 16 February 2000, applicants filed international application PCT/EP00/01272. On 24 August 2000, a Demand was filed with the International Preliminary Examining Authority within nineteen months of the priority date, in which the United States was elected. Accordingly, the deadline for entry into the national stage in the United States was midnight on 17 August 2001.

On 14 August 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 06 September 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the fee for filing the oath or declaration later than thirty months were required.

On 06 March 2002, applicants filed a response to Notification of Missing Requirements accompanied by, *inter alia*, a declaration executed by heirs of the deceased, a petition for a four month extension of time and the fee for the four month extension of time.

On 27 March 2002, the Office mailed Decision on Papers Under 37 CFR 1.42 refusing applicants' request for status.

On 17 January 2003, the Office mailed Decision On Request Under 37 CFR 1.42, refusing applicants' request.

On 15 April 2003, applicants submitted "Renewed Submission Under 37 C.F.R. §1.42."

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42. As "the terms 'Executor' and 'Administrator do not have exact counterparts in all foreign countries, ... the terms must be construed to fit the circumstances of the case." MPEP 409.01(d). Thus, "the person or persons having authority corresponding to that of executor or administrator are permitted to make application..." MPEP 409.01(d).

Counsel for applicants has stated that Yahya Haghiri had four heirs: Szahra Haghiri, Mana Haghiri, Sina Haghiri and Touba Haghiri.

The 06 March 2002 declaration failed to list either the information for the deceased inventor or for Touba Haghiri. The 21 October 2002 declaration listed contradictory citizenships for Yahya Haghiri and only listed two of the heirs. The 15 April 2003 declaration lists consistent citizenship for Yahya Haghiri, but again the declaration only lists two of the heirs and is only executed by Touba Haghiri on her behalf and on behalf of Sina Haghiri.

It is noted that a minor may execute a declaration if the minor has capacity, i.e. understands the document. MPEP §409. It is noted that Sina Haghiri is sixteen years old. A legal representative may sign for a minor if the minor lacks capacity.

CONCLUSION

For the above reasons, the request for status under 37 C.F.R. 1.42 is **REFUSED**.

Applicant is required to submit an oath or declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. **THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 C.F.R. 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.** Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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